

Applic. No. 09/981,847

Amdt. dated April 5, 2005

Reply to Office action of January 5, 2005

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1 and 3-13 are now in the application. Claims 1, 3, and 10-12 have been amended. Claim 2 has been cancelled. Claim 13 has been added. Support for claim 13 can be found on page 17, lines 14-24 of the specification. No new matter has been added.

In the third paragraph on page 2 of the above-identified Office action, claims 1-3, 5, 9, and 12 have been objected to for the following minor informalities.

The Examiner suggested adding colons in claims 1, 2, 3, and 12. Colons have been included in claims 1, 3, and 12. As noted above, claim 2 has been cancelled.

The Examiner stated that claims 5-6 and 9 are objected to for improper grammar. Applicants respectfully disagree with the Examiner, the term "data" is plural. The singular form is "datum". Accordingly, the verbs "are" and "were" are correctly used. Therefore, the claims have not been amended to overcome the objection by the Examiner.

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The Examiner stated that claim 12 is objected to for improper grammar and inconsistent terminology. Claim 12 has been amended so as to further clarify the claims and to prosecute the application. Therefore, the objection to claim 12 by the Examiner is believed to have been overcome.

In the second paragraph on page 3 of the above-identified Office action, claims 1 and 12 have been objected to as being indefinite under 35 U.S.C. § 112.

More specifically, the Examiner has stated that there is insufficient antecedent basis for the limitation of "the printing press" in claims 10 and 11. Claims 10 and 11 have been amended so as to facilitate prosecution of the application. Therefore, the rejection is believed to have been overcome.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for cosmetic or clarificatory reasons. The changes are not provided for

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overcoming the prior art nor for any reason related to the statutory requirements for a patent.

In the penultimate paragraph on page 3 of the Office action, claims 1 and 12 have been rejected as being fully anticipated by Sridhar et al. (U.S. Patent No. 6,098,108) (hereinafter "Sridhar") under 35 U.S.C. § 102.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found in claim 2 of the instant application and on page 17, lines 22-23 of the specification.

As noted above, claim 1 has been amended to include the subject matter of claim 2. Therefore, claim 1 is believed to be allowable over Sridhar.

Claim 12 has been amended to include the subject matter of claim 2. Therefore, claim 12 is believed to be allowable over Sridhar as well.

In the first paragraph on page 6 of the Office action, claim 2 has been rejected as being obvious over Sridhar (U.S. Patent

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No. 6,098,108) in view of Collin et al. (WO 00/49501)

(hereinafter "Collin") under 35 U.S.C. § 103.

Since claims 1 and 12 have been amended to include the subject matter of claim 2, claims 1 and 12 will be discussed with regard to this rejection.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 12 call for, *inter alia*:

displaying a specified number of diagnostic programs stored in the second computing unit after the data connection is established, and selecting and starting one of the diagnostic programs via the first computing unit.

The Collin reference discloses that a display of information can be used to assist a user when performing diagnostics such as modifying a configuration of a modem system and optimizing communications between the computer system and another computer system.

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It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest displaying a specified number of diagnostic programs stored in the second computing unit after the data connection is established, and selecting and starting one of the diagnostic programs via the first computing unit, as recited in claims 1 and 12 of the instant application.

The diagnostic programs stored in the memory of the second computing unit of the present invention is completely different than the disclosure of Collin to perform diagnostics such as modifying a computer configuration. The diagnostic programs of the present invention are already stored in the second computing unit and are used to monitor and perform diagnostics on a printing press (new claim 13). This is contrary to Collin, which is silent about the location of the diagnostics program and which is silent about there being several diagnostic programs that an operator can choose between. Therefore, Collin does not disclose displaying a specified number of diagnostic programs stored in a second computing unit after the data connection is established, and selecting and starting one of the diagnostic programs via the

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first computing unit, as recited in claims 1 and 12 of the instant application.

Sridhar does not disclose displaying a specified number of diagnostic programs stored in the second computing unit after the data connection is established, and selecting and starting one of the diagnostic programs via the first computing unit, as recited in claims 1 and 12 of the instant application.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Since claim 1 is believed to be allowable, dependent claim 13 is believed to be allowable as well.

Even though claim 13 is believed to be allowable, it is noted that Collin discloses that the diagnostics are used only to modify a computer system and not a printing press, as is disclosed in claim 13 of the instant application.

In the second paragraph on page 7 of the Office action, claims 3-7 and 9 have been rejected as being obvious over by Sridhar (U.S. Patent No. 6,098,108) in view of Collin (WO 00/49501) and further in view of Waite et al. (U.S. Patent No.

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4,688,170) (hereinafter "Waite") under 35 U.S.C. § 103. Waite does not make up for the deficiencies of Sridhar and Collin. Since claim 1 is believed to be allowable, dependent claims 3-7 and 9 are believed to be allowable as well.

In the third paragraph on page 9 of the Office action, claim 8 has been rejected as being obvious over by Sridhar (U.S. Patent No. 6,098,108) in view of Collin (WO 00/49501) and further in view of Official Notice under 35 U.S.C. § 103. Since claim 1 is believed to be allowable, dependent claim 8 is believed to be allowable as well.

In the second paragraph on page 10 of the Office action, claims 10 and 11 have been rejected as being obvious over by Sridhar (U.S. Patent No. 6,098,108) in view of Collin (WO 00/49501) and further in view of Waite (U.S. Patent No. 4,688,170) under 35 U.S.C. § 103. Waite does not make up for the deficiencies of Sridhar and Collin. Since claim 1 is believed to be allowable, dependent claims 10 and 11 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art and since

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all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

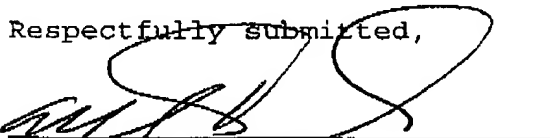
In view of the foregoing, reconsideration and allowance of claims 1 and 3-13 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,


For Applicant(s)

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